



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/821,259

03/29/2001

Mark M. Ishikawa

60123.801US01

7236

22877

7590

05/31/2005

FERNANDEZ & ASSOCIATES LLP
1047 EL CAMINO REAL
SUITE 201
MENLO PARK, CA 94025

EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,259

Applicant(s)

ISHIKAWA, MARK M.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

Art Unit: 3622

DETAILED ACTION

1. Claims 1-13 have been examined.

Response to Amendment

2. The Amendment filed on 12/3/04 is sufficient to overcome the Angles reference. A new reference has been added to the 35 USC 103 rejection.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/6/05 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles (5,933,811) in view of Gerace (5,848,396).

Art Unit: 3622

Claim 1, 7, 9: Angles discloses a method, system for authenticating the distribution of an advertisement for data and a request for the data in response to the advertisement on a network having at least one user computer and one provider computer, wherein the response to the advertisement is preceded by the distribution of the advertisement to the user computer from an advertiser, comprising:

- creating a confirmation code upon the transmission of the advertisement to the user computer; wherein the confirmation code comprises a first user code (col 3, lines 17-29; col 8, lines 8-16);

- associating the confirmation code with the advertisement (col 19, lines 7-11);

- transmitting a request from the user computer for the data identified in the advertisement to the provider computer (col 20, lines 16-26);

- transmitting a second user information piece generated by the transmission protocols to the provider computer (col 20, lines 47-57; col 7, lines 10-42);

- transmitting the confirmation code to the provider computer (col 8, lines 7-15);

- determining the authenticity of the data request from the user (col 22, lines 41-50).

Angles further discloses a data interface (col 3, lines 24-30; col 20, lines 16-26).

Additionally, the above features are disclosed in the Figures (Fig. 1, Fig. 4, Fig. 7, Fig. 11).

Angles further discloses preassigning a content provider code (col 3, lines 30-40) and uniquely identifying an advertiser (col 21, lines 5-25; col 25, lines 5-8).

Angles does not explicitly disclose that the second user information piece are codes.

Art Unit: 3622

However, Angles discloses that the second user information is categorized and grouped (col 20, lines 53-60) and Angles discloses utilizing codes (col 3, lines 23-26).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Angles's information that is to be grouped and categorized can be in the form of codes. One would have been motivated to do this in order to provide the information in a form that is easily transmittable and easily grouped or categorized.

Also, Angles discloses both a special software data interface (col 3, lines 24-30) and a browser data interface (col 1, lines 45-55; col 4, lines 26-35). Angles discloses creating identifying indicia upon user registration (col 17, lines 10-25) and creating identifying indicia upon providing a specialized data interface (col 3, lines 20-30). Angles discloses that the user computer generates codes for identifying which advertisements from the user computer were viewed or not (Fig. 4, item 12; Fig. 11, item 12; col 19, lines 1-11). Angles uniquely identifies each advertisement that the user views or requests to view (col 20, lines 15-37). Angles uniquely identifies a variety of the actions taken or information displayed by or to the user (col 19, lines 1-11). Angles uniquely identifies when an advertisement is sent to the user, uniquely identifies when a link is provided to the user for clicking on to see an advertisement, and uniquely identifies when the user requests to see that advertisement. Angles was combined with itself to demonstrate that codes can be utilized for these uniquely identified actions and information transmission back and forth.

Art Unit: 3622

Additionally, Angles discloses providing a data interface to a user where the data interface is predefined data such as product or service information (col 1, lines 6-12; col 2, lines 19-41).

Angles discloses targeting a user (col 2, lines 28-42).

Gerace discloses providing a data interface to a user where the data interface is predefined data such as product or service information (col 2, lines 24-42).

Gerace discloses targeting a user (col 2, lines 30-35).

Gerace discloses identifying the user computer via user computer ID (Fig. 3D), uniquely identifying each user and user session via referring link, star time, end time, computer ID, etc (Fig. 3E), uniquely identifying all user activity (Fig. 3F; Fig. 3G), and uniquely identifying an advertiser and the advertisements that the advertiser provides (Fig. 5a; Fig. 5D).

Gerace further discloses dynamic generating of identifying indicia, that identifiers can utilize IP address and/or time stamps, that there are identifying indicia comprising user identification code and the advertiser code; and Gerace also discloses a second user identification code sent to the provider computer from the user computer, wherein said second user identification code comprises current user information to identify the user. . . such as user's IP address, time stamp, etc:

“(20) Also the Sponsor and User Objects track how many times each piece of advertisement information is shown to, is selected by and/or spawns a purchase by users. In other words, the Sponsor and User Objects track performance of sponsor provided information, especially advertisements. In the preferred embodiment, a performance routine employs

Art Unit: 3622

regression techniques to provide performance reports. The performance routine may also be run (executed) remotely by suppliers of the advertisement information (col 3, lines 10-20);

(5) In addition, program 31 records the user's selections and his viewing activity with respect to the agate information. In particular, for each piece of displayed agate information, program 31 records the date and time of user viewing and the format which the user has selected for viewing (col 4, lines 10-15);

(21) Each time a user logs on to program 31, User Session Object 37d records the starting date and time and ending date and time of the session. User Session Object 37d also records (a) the referring link from which the user accessed program 31 (e.g., a so called "bookmark" or "hyperlink" which effectively stores and forwards the Web site address of program 31), (b) the user's identification number (e.g., as stored in a so called "cookie" passed by the user's computer upon logging in), and (c) an indication of Web browser software employed by the user's computer. FIG. 3e illustrates the records created by User Session Object 37d to accommodate the foregoing data;

(22) The User Action History Object 37e stores each click of a mouse and corresponding cursor position to effectively record the user's motions/movements in a session. In particular, as illustrated in FIG. 3f, User Action History Object 37e records (a) date and time of action, (b) session identifier (indicating in which session of the User Session Object 37d the subject action occurred), (c) sequence or order number of the action in the series of actions that occurred in a common session, (d) identification of screen view displayed at time action occurred, (e) identification of item selected by user (via click of mouse with cursor positioned on item), and (f) screen position of selected item (e.g., first, second or third menu item, right

Art Unit: 3622

or left side);

(23) The User Viewing History Object 37f stores information indicative of the screen views displayed to the user in a session. Specifically, User Viewing History Object 37f records an item identification (either agate or advertisement) and orientation of that item for each item displayed to (and hence viewed by) the user in a session. Orientation is noted relative to a page/screen view or an object identified in the "related object ID" field of the User Viewing History Object 37f. Preferably, orientation is indicated as being top, bottom, left, right or background of the screen view. The Viewing History Object 37f also records an identifier (of each screen view), ordinal sequence number (number order of screen view within series of screen views displayed in a session), and an indication of the action from which this screen view resulted (i.e., a reference to a corresponding User Action History Object 37e). Lastly, the User Viewing History Object 37f records date and time of screen opening and closing for each screen view. The foregoing is stored in an object table record illustrated in FIG. 3g (col 6, line 45-col 7, line 22);

(50) For each sponsor (or advertiser), a corresponding Sponsor Object 33a (FIG. 5a) stores in a table (or sponsor directory) the company name, numeric identification unique to that sponsor, user contact information and program 31 administrator contact information. Also Sponsor Object 33a records an indication of the demographic profile of the sponsor company itself in order to advertise to the sponsor company user as is appropriate. Further, Sponsor Object 33a indicates standardized report configurations (display preferences, etc.) for that sponsor (col 11, line 64-col 12, line 6);

Art Unit: 3622

(63) For a new user, the Home Page 43 effectively requests a user name and password. In response to the user-provided data, main routine 39 immediately builds a cookie if possible. Included in the newly built cookie is a unique user identification code (preferably numeric), time and date of login, and computer identification number to distinguish between home and work logins. Main routine 39/server 27 transmits the created cookie to the user's PC for storage and future use" (col 13, line 61-col 14, line 4).

Note that in Gerace that identifiers are dynamically created and utilized for identifying and tracking the user, to identify the user, the user's actions, the computer ID, the session ID, the advertiser involved, the advertisements involved, the time and date of actions.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's further identifying, tracking, and targeting features to Angles' targeting capabilities. One would have been motivated to do this in order to better target the user. Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art.

Claim 2, 10: Angles and Gerace discloses a method as claimed in claim 9. Angles further discloses determining the authenticity of the data request further comprises comparing a portion of the identifying indicia and the second user code (col 22, lines 41-50; col 20, lines 47-57; col 11, lines 11-25).

Claim 3, 11: Angles and Gerace disclose a method as claimed in claim 9.

Angles does not explicitly disclose an advertiser code.

Art Unit: 3622

However, Angles discloses a content provider code (col 3, lines 30-40) and uniquely identifying an advertiser (col 21, lines 5-25; col 25, lines 5-8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Angle's identity identifying codes to Angle's uniquely identifying and advertiser. One would have been motivated to do this in order to provide an effective way to uniquely identify an advertiser.

Claim 4, 12: Angles and Gerace disclose a method as claimed in 11. Angles further discloses creating of a confirmation code comprises dynamically generating the first user code and combining the first user code and advertiser code (col 19, lines 1-11).

Claim 5: Angles and Gerace disclose a method as claimed in claim 1. Angles further discloses that the user computer and provider computers operate in accordance with transmission protocols, and further comprising dynamically generating the second user code via the transmission protocols (col 7, lines 10-42; col 22, lines 41-50; col 20, lines 47-57; col 11, lines 11-25).

Claim 6, 8: Angles and Gerace disclose a method as claimed in claim 1. Angles further discloses:

comparing, on the provider computer, a portion of the identifying indicia with the second user code to determine a degree of match; and

providing, from the provider computer, information regarding the degree of match determined by comparing the portion of the identifying indicia and second user code (col 22, lines 41-50; col 20, lines 47-57; col 11, lines 11-25; col 11, lines 20-25).

Art Unit: 3622

Claim 13: Angles and Gerace disclose a method as claimed in 11. Angles further discloses storing the advertiser code in a database in association with the advertiser (col 21, lines 5-25).

Response to Arguments

5. Applicant's arguments with respect to claims 1-13 have been considered but are moot in grounds of the new rejection. Please particularly note the addition of citations, examples, and a reference in the rejection of the independent claims starting with the section stating, "Additionally, Angles discloses providing a data interface to a user where the data interface is. . .".

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Patent Examiner
5/26/05